

### **REMARKS**

Claims 1, 2, 5-10, 27 and 28 are active in the present application. Claims 3, 4 and 11-26 were withdrawn in response to a prior Office Action.

#### **Prior Art Rejection**

Claims 1, 2, 5-7, 10, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,000,240 (Inoue) in view of U.S. Patent No. 5,600,628 (Spector). It is the Examiner's position that the Inoue patent discloses a disc cartridge for storing a disc having a first side, a first functional portion and a second side, the disc cartridge including a cartridge body, a chucking opening, a head opening and a disc window where the disc is stored therein so that the first side is exposed to the disc window. The Examiner further states that other portions of the claimed structure of the present disc cartridge are also included. Finally, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to provide the Inoue patent disc cartridge with a design style utilizing an image on the disc and the completed image on the panel of the cartridge as taught by the Spector patent. For the reasons as set forth below, the Applicants respectfully traverse the rejection of claims 1, 2, 5-7, 10, 27 and 28.

1. Enclosed with this Response is a Certified English Translation of Japanese Patent Application No. 2002-221000. The present application is a Section 371 of International Application PCT/JP03/09359 which was filed on July 23, 2003. The Japanese PCT application claims priority from Japanese Patent Application No. 2002-221000 which was filed on July 30, 2002. Accordingly, the present application claims a priority date from the Japanese priority application of July 30, 2002.

Referring to the English language translation of the Japanese priority document, it can be seen that Figures 1-10 of the Japanese priority document are substantially the same as Figures 11-21 of the present application. Additionally, the description in the English translation of the Japanese priority document relating to embodiments 1-5 (pages 20-35 of the English translation) is similar to the description of the five embodiments which appears on pages 30-63 of the present application. Further, as demonstrated by the attached claim chart, all of the claims currently

active in the present application are either directly supported or inherently supported by the Japanese priority document.

The Inoue patent is based upon a Section 371 of International Patent Application No. PCT/JP02/09821 filed on May 29, 2003, claiming priority from a Japanese Patent Application (2001-305812) filed on October 1, 2001. The English language translation of the Japanese priority application of the present application was filed less than one year after the Japanese priority application for the Inoue patent and almost two months before the Inoue PCT application was filed in Japanese. The Inoue PCT application was published in Japanese on April 17, 2003, after the filing date of the Japanese priority application of the present application. Accordingly, the Inoue patent does not qualify as “prior art” under 35 U.S.C. § 102(e) and should be withdrawn.

Because the Inoue patent does not qualify as prior art as described above, it is respectfully submitted that the rejection of claims 1, 2, 5-7, 10, 27 and 28 should be withdrawn.

2. It is respectfully submitted that the rejection of claims 1, 2, 5-7, 10, 27 and 28 should also be withdrawn because the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). In paragraph 3 of the Office Action, the Examiner describes the structural features of the disc-encasing cartridge shown and described in the Inoue patent. Beginning at the middle of page 4 of the Office Action, the Examiner describes in detail some of the structural features of the protective package or album shown and described in the Spector patent. At the bottom of page 4 of the Office Action, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Inoue cartridge with the design style utilized on the protective package shown and described in the Spector patent. The only support provided by the Examiner for reaching the obviousness conclusion that these two references should be combined is that “this will provide the user with a visual image of the audio content of the disc” and that “this audio visual effect would be near the disc window.”

The Examiner has pointed to no specific disclosure, teaching or suggestion in the Inoue patent of the desirability of adding any type of visual, audio or other effect on the upper surface of the Inoue disc cartridge. In fact, it is respectfully submitted that the Inoue patent actually

teaches away from the use of any such design because it specifically discloses that the cartridge (1) should be loaded into a recorder/player (70) as shown in Figs. 17 and 18 in a manner so that neither the disc nor the disc cartridge are visible while the cartridge and the disc are loaded into the recorder/player. Accordingly, it is respectfully submitted that the Inoue patent actually teaches away from the claimed concept of an audio visual effect on the disc cartridge which cooperates with the first function or portion of the disc since the effect would not be seen in the Inoue recorder/player..

The Spector patent does disclose a disc having a design on the top surface which coordinates with a complementary design placed on the interior surface of the album or jewel box which is used to receive and protect the disc during transport or storage. It is abundantly clear that the album or jewel box is not the same as, nor is it equivalent to, the claimed disc cartridge of the present application or the disc cartridge as disclosed in the Inoue patent. More particularly, the album or jewel box disclosed in the Spector patent is used only for transport or storage of the disc and is not adapted for retaining the disc while the disc is being read from or written to and clearly is not adapted for being placed into a reader of the type disclosed in the present application or in the Inoue patent. The Applicants have carefully reviewed the Spector patent and can find no disclosure, teaching or suggestion that the design imposed on the disc and the complementary design imposed on the inside surface of the album or jewel box could in any way be applicable with respect to a disc-receiving cartridge. In fact, it is respectfully submitted that the Spector patent actually teaches away from the disc-receiving cartridge of Inoue because the album of the Spector patent is used only for transport or storage of the disc.

In view of the foregoing discussion, it is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness by not referring to a specific teaching or suggestion in either the Inoue patent or the Spector patent which would in any way support the combination of these two patents alleged by the Examiner. It is therefore respectfully submitted that the rejection under 35 U.S.C. § 103(a) of claims 1, 2, 5-10, 27 and 28 should be withdrawn.

**Conclusion**

In view of the foregoing discussion, it is respectfully submitted that the present application, including claims 1, 2, 5-10, 27 and 28 is in condition for allowance and such action is respectfully solicited.

Respectfully submitted,

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Enclosures: Certified English Translation of Japanese Patent Application No. 2002-221000  
Claim Chart